

REMARKS

Reconsideration of the rejections set forth in the Office Action mailed July 1, 2003, is respectfully requested. Claims 1-5, 15-30, and 32-33 have been amended. Claim 31 has been canceled. Claims 1-5, 15-30, and 32-33 remain pending. Support for the amendments can be found in the specification at, e.g., page 10, lines 9-17 and claim 31. Therefore, these amendments have been made without the addition of new matter.

35 U.S.C. § 112

Claims 1-5 and 15-33 were rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. In particular, the examiner alleges that, although the preamble of claim 1 directs the invention to a device that is both electronically addressable as well as being a microchip with electronically programmable microlocations, there are no actual component limitations in the claims. Applicant has amended the preamble of claim 1 to recite "*A device comprising a plurality of microlocations ...*"

35 U.S.C. § 103

Claims 1, 2, 4, 15, and 31-33 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bosley et al (EP 0,226,470). The examiner apparently takes the opinion that, although this reference lacks testing of any current density values for which the permeation layer is stable, the reference describes structures that would be expected to have the same stability character as the instant invention. The examiner then argues that the burden is shifted to the applicants to distinguish the instant invention over the described reference.

Applicants have amended claim 1 to specify that the “*permeation layer material is stable at a current density of at least 0.10 nA/μm²*” and submit herewith a Declaration by Theodore M. Winger. Dr. Winger is an inventor on the present application and an expert in the field of microarray technology. In his Declaration, Dr. Winger explains that the fact that the permeation layer is stable at a current density of at least 0.10 nA/μm² for the microchips wherein the linker molecules were attached to the electrode by vapor deposition. (Winger Declaration, ¶ 4). In addition, he states that it was entirely unexpected that vapor deposited microchips would have superior stability characteristics in comparison to microchips where the linker molecules were attached to the electrode surface by a solution phase reaction. (Winger Declaration, ¶¶ 4-5). *See In re Soni*, 54 F.3d 746, 751 (Fed. Cir. 1995) (“when an applicant demonstrates *substantially* improved results ... and states that the results were *unexpected*, this should suffice to establish unexpected results *in the absence of evidence* to the contrary.”)

For all the foregoing reasons, Applicants assert the claims are in condition for allowance. Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicants’ undersigned representative at (949)737-2900. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 50-0639.

Respectfully submitted,
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Dated: October 13, 2003

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